

Appl. No. 10/069,177
Amdt. Dated September 22, 2004
Reply to Office Action of July 2, 2004

REMARKS

The Office Action mailed on July 2, 2004, is hereby acknowledged. Presently, claims 1-18 are pending. Applicants request re-examination of the present application in view of the above amendments and following remarks.

Amendments to the Claims

Above, Applicants have amended claims 2, 4, 7, 8, 12, 14 and 16.

In the present Office Action, the Examiner indicates claims 2, 4, 7, 14 and 16 contain allowable subject matter and would be allowable if rewritten in independent form. Accordingly, Applicants have rewritten these claims in independent form by incorporating the limitations of the base claim of each and all intervening claims. Thus, Applicants believe claims 2, 4, 7, 14 and 16 are each in condition for allowance, as are all claims ultimately depending therefrom.

Applicants have amended claim 8 in order to correct a grammatical error. The amendment made to claim 8 deletes the comma following the word "wherein" and adds a comma after the number "5."

Similarly, the Applicants amended claim 12 to correct a typographical error. In particular, Applicants corrected the typographical error with the term "out flow." This claim term should be one word, "outflow," in order to maintain proper antecedent basis. Applicants have, therefore, amended claim 12 to read as such.

Claim Rejections under 35 U.S.C. § 102

The Examiner rejects claims 1, 3, 12, 13, 15 and 17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,597,460 issued to Reynolds. The Examiner maintains the rejections of these claims from the Office Action mailed on October 6, 2003 (hereinafter "the previous Office Action").

Claim 1

As set forth in the previous Office Action, which the Examiner incorporates into the present Office Action by reference, the Examiner rejects claim 1 because

Reynolds teaches an arrangement enabling a liquid to flow evenly around a surface of a sample, said arrangement comprising:

- a flow chamber having said liquid flowing therethrough (Fig. 1, numeral 10);
- a sample located at least in part in said flow chamber and rotatable about an axis of rotation by means of a rotary drive (col. 5, lines 1-15);
- inflow and outflow pipes each exiting to opposite ends of the flow chamber from inflow and outflow containers, respectively (Fig. 1, numerals 44 and 30 where numeral 30 obtains fluid from just below numeral 20 at the weir);
- an inflow tube terminating in the inflow container (Fig. 1, numeral 38);
- an outflow tube beginning in the outflow container (Fig. 1, numeral 38);
- a flow generator (Fig. 1, numeral 34);
- filters arranged in the inflow and/or outflow container or in the inflow and outflow pipes, respectively, and having the liquid flowing therethrough (Fig. 1, numeral 36);
- wherein the inflow and outflow pipes extend in opposite ends of the flow chamber and the outflow tube begins in the outflow container (Fig. 1, numeral 30 and Fig. 1, numerals 44 and 30 where numeral 30 obtains fluid from just below numeral 20 at the weir).

As set forth in the Amendment of the Applicants responding to the previous Office Action and mailed on April 6, 2004 (hereinafter referred to as the "previous Amendment"), Applicants respectfully disagree with this characterization.

In the current Office Action, the Examiner addressed arguments of the Applicants set forth in the previous Amendment. Specifically, the Examiner addressed the argument that Reynolds failed to teach an outflow container, an outflow tube, and an inflow tube. The Examiner asserted:

Applicant's "outflow container" is essentially a fluid reservoir. As such, Reynolds discloses a fluid reservoir as "holding tank 38" (Fig. 1, and col. 5, lines 20-21). Applicant argues that their invention has two distinct and separate containers, namely an inflow and outflow container. However, in interpreting the claims and applying the Reynolds reference, Examiner must point out that each container in Reynolds (i.e. tank 38 and plating cell 10) can act as either an inflow container and an outflow container because each container has fluid flowing into

it and fluid flowing out of it. This fact should have been clearly apparent to Applicant.

Applicants respectfully disagree with this characterization of the prior art by the Examiner.

Claim 1 requires the claimed arrangement include, in part, a flow chamber, an inflow container and an outflow container. Inflow pipes connect the inflow container to the flow chamber at a first end, and outflow pipes connect the outflow container to the flow chamber at a second end. Accordingly, claim 1 requires three separate and distinct "fluid reservoirs" (using the language of the Examiner): 1.) an inflow container, 2.) an outflow container and 3.) a flow chamber.

Reynolds does not teach three distinct "fluid reservoirs." Moreover, the Examiner has yet to even demonstrate how Reynolds includes three "fluid reservoirs." When rejecting claim 1 in the previous Office Action, the Examiner characterized the plating cell 10 as a flow chamber. The Examiner then characterized holding tank 38 as both the inflow container and outflow container. After Applicants explained in the previous Amendment the failure to indicate an outflow container in Reynolds, the Examiner responded by explaining that the tank 38 and plating cell 10 satisfy the inflow and outflow container requirements. This position is inconsistent with the position in the previous Office Action, since the Examiner had previously characterized the plating cell 10 as a flow chamber. In other words, the Examiner has characterized the plating cell 10 of Reynolds as both a flow chamber and one of an inflow or outflow container. However, the plating cell 10 can not represent two distinct components if Reynolds anticipates claim 1.

In characterizing Reynolds and addressing the arguments of the Applicants, the Examiner has repeatedly failed to demonstrate that Reynolds teaches three "fluid reservoirs" (using the language of the Examiner), specifically, a flow chamber, an inflow container and an outflow container. At best, Reynolds teaches only two "fluid reservoirs," tank 38 and plating cell 10. Reynolds does not teach a third "fluid reservoir." "Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it [the prior art] to anticipate the claim." *Getcher v. Davidson*, 116 F.3d 1454, 1457, 43 U.S.P.Q.2d

1030, 1032 (Fed. Cir. 1997) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Since Reynolds fails to disclose at least one of a flow chamber, an inflow container or an outflow container, Reynolds cannot anticipate claim 1. Accordingly, Applicants believe claim 1 is allowable over Reynolds.

Claim 12

As set forth in the previous Office Action, which the Examiner incorporates into the present Office Action by reference, the Examiner asserts:

Reynolds teaches an arrangement enabling a liquid to flow evenly around a surface of a sample, said arrangement comprising:

- a flow chamber profiled for allowing liquid to flow therethrough (Fig. 1, numeral 10);
- a rotary drive mechanism having a sample mounting surface profiled relative to said flow chamber whereby a sample can be located at least in part in said flow chamber and rotatable about an axis of rotation by said rotary drive mechanism (col. 5, lines 1-15);
- [a]n inflow manifold and an outflow manifold positioned on opposite ends of the flow chamber (Fig. 1, numerals 44 and 30 where numeral 30 obtains fluid from just below numeral 20 at the weir);
- each manifold having flow tubes extending from said respective manifold and into said flow chamber (Fig. 1, numeral 38), said manifolds and said flow tubes defining a laminar flow pattern through said flow chamber (col. 6, lines 36-46).

Applicants respectfully disagree with this characterization.

The arrangement set forth in claim 12 includes, in part, a flow chamber, an inflow manifold and an outflow manifold. Claim 12 further requires that the manifolds be positioned on opposing ends of the flow chamber. In addition, claim 12 requires that flow tubes connect each manifold to the flow chamber. Reynolds does not teach this.

The Examiner addressed Applicant's arguments in the present Office Action. In response to the Applicant's assertions that Reynolds fails to teach inflow and outflow manifolds positioned on opposite ends of the flow chamber, the Examiner explained:

Examiner must respectfully disagree. In fact, Examiner pointed out in the previous Office action that an inflow manifold and an outflow manifold are positioned on opposite ends of said flow chamber (Fig. 1, numerals 44 and 30 where numeral 30 obtains fluid from just below numeral 20 at the weir). While Reynolds does not go into detail about the flow just below numeral 20 at the weir, it appears that numeral 30 extends to that location, although not viewable from Fig. 1.

This characterization fails to address all of the claim elements set forth in claim 12. According to the above statement, the Examiner characterizes the pipes 30, 44 of Reynolds as inflow and outflow manifolds. If this is true, however, Reynolds then fails to teach flow tubes extending from the manifolds to connect the manifolds to the flow chamber.

In Reynolds, a pair of flow tubes, indicated by numerals 30 and 44, connects the plating cell 10 to the tank 38. The flow tubes 30, 44 extend from opposing sides of the tank 38 and into one side of the plating cell 10. Reynolds does not disclose a flow chamber, a pair of flow tubes and a pair of manifolds, nor has the Examiner ever explained which components of Reynolds represent these claim limitations. Specifically, the Examiner characterizes the pipes 30, 44 of Reynolds as "manifolds" and the plating cell 10 as a "flow chamber." The Examiner fails to explain which components represent flow tubes, since the pipes 30, 44 have been characterized as manifolds.

The Examiner has failed to explain how Reynolds teaches a flow chamber, an inflow tube, an outflow tube, an inflow manifold and an outflow manifold. Therefore, Reynolds fails to anticipate claim 12 under 35 U.S.C. § 102 since Reynolds does not teach every element of this claim. Thus, Applicants believe claim 12 is allowable over Reynolds.

CONCLUSION

Since Applicants have amended claims 2, 4, 7, 14 and 16 to include the base claim and all intervening claims in the manner indicated by the Examiner, Applicants believe these claims are in condition for allowance, as are any claims depending therefrom.

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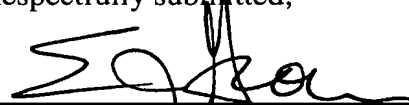
In addition, Applicants also believe that Reynolds fails to teach at least one of a flow chamber, an inflow tube, an inflow container, an outflow tube and an outflow container as recited in claim 1. Thus, Applicants assert that claim 1 is also in condition for allowance.

Finally, Applicants further believe that Reynolds fails to teach at least one of a flow chamber, an inflow manifold, an outflow manifold, and a pair of flow tubes each connecting one of the manifolds to the flow chamber, as set forth in claim 12. Accordingly, Applicants believe Reynolds does not anticipate claim 12 and thus, claim 12 is allowable over Reynolds.

Based upon the above, it is clear that all of the independent claims of the present application are allowable over Reynolds. Furthermore, as each of the remaining claims depends from the independent claims, Applicants believe all pending claims are allowable. Moreover, with the acceptance of the drawings by the Examiner, Applicants believe the application is in condition for allowance and respectfully request passage thereof.

For all of the foregoing comments, applicants believe that the current application is in condition for allowance, and respectfully request early passage thereof. If necessary to effect a timely response, please consider this paper a request for an extension of time, and charge any shortages in fees, or apply any overpayment credits, to Baker & Daniels' Deposit Account No. 02-0387 (72262.90022). However, please do not include the payment of issue fees.

Respectfully submitted,



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